

In the Office Communication dated November 1, 2000, the Examiner has cited *In re Kroekel, et al.*, 231 U.S.P.Q. 640 (CAFC 1986) as authority to prevent Applicants from presenting the present claims in *ex parte* proceedings. In *Kroekel*, the Court denied applicants' argument that they had no obligation to broaden the lost claim during the interference proceeding, but could show via Rule 1.131 affidavits that they were the first inventors of the generic invention. The Applicants respectfully disagree with the Examiner's assertion that *In re Kroekel* is applicable. In *Kroekel*, the applicants were attempting to broaden claims. In the prior interference, only the "species" that was common to both applications was adjudicated. *Kroekel* did not attempt to include the genus in the interference. The amended claim he presented after the interference did "not exclude the precise subject matter lost in the interference." *Kroekel* at 644. The Court stated "[i]f [a] claim [is] patentably distinct from the lost count, it [can] not be denied to [Applicants] on the sole ground of interference estoppel." *Id.* at 643 (citation omitted). In the present application, the Applicants are narrowing the claims so as to exclude the precise subject matter lost in the interference and to be patentably distinct from the Count of the interference. The applicants are not trying to broaden their claims, but instead narrow their claims. For the above reasons, the applicants do not believe that *In re Koekel* is related to the Applicants situation. The applicants again believe that *Ex parte Deckler* 21 USPQ 2d 1872 (Bd. App. 1991) is the case that should be used as precedent (see in particular page 6 of the amendment filed October 3, 2000). For the above reasons, the applicants respectfully request that this rejection be withdrawn.

The applicants do not believe that there are any fees due. However, if there are any fees due in connection with the filing of this response, including any fees required for an additional extension of time under 37 CFR 1.136, such an

extension is requested and the Commissioner is authorized to charge any debit or credit any overpayment to Deposit Account No. 03-2775.

For the reasons set forth above, Applicants believe that the claims are patentable and a prompt and favorable action is solicited. The applicants believe that these claims are in condition for allowance, however, if the Examiner disagrees, the applicants respectfully request that the Examiner telephone the undersigned at (302) 888-6270.

Respectfully submitted,  
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